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EXAMINER

SRIVASTAVA, D

ART UNIT

PAPER NUMBER

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DATE MAILED: 09/03/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/962,560

Applicant(s)
Hilton et al.

Examiner
Devash Srivastava, Ph.D.

Group Art Unit
1653



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-40 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The-oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-15, drawn to a(n isolated) nucleic acid molecule comprising a sequence encoding a SOCS box motif, classified in class 536, subclass 23.1.

Claims 13-14 are generic to a plurality of disclosed patentably distinct species comprising an isolated nucleic acid molecule encoding a polypeptide with the amino acid sequence set forth in SEQ ID NO: 4, 6, 8, 10, 12, 14, 18, 21, 25, 29, 36, 41, 44, 46 or 48 or comprising a nucleic acid sequence set forth in SEQ ID NO: 3, 5, 7, 9, 11, 13, 15, 16, 17, 20, 22, 23, 24, 26, 27, 28, 30, 31, 32, 33, 34, 35, 37, 38, 39, 40, 42, 43, 45 or 47. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

II. Claims 16-30, drawn to an isolated protein comprising a SOCS box motif, classified in class 530, subclass 350.

Claims 28-29 are generic to a plurality of disclosed patentably distinct species comprising an isolated polypeptide comprising an amino acid sequence set forth in SEQ ID NO: 4, 6, 8, 10, 12, 14, 18, 21, 25, 29, 36, 41, 44, 46 or 48 or encoded by a nucleic acid sequence set forth

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in SEQ ID NO:3, 5, 7, 9, 11, 13, 15, 16, 17, 20, 22, 23, 24, 26, 27, 28, 30, 31, 32, 33, 34, 35, 37, 38, 39, 40, 42, 43, 45 or 47. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

III. Claim 31, drawn to a method of modulating levels of a SOCS protein in a cell, classified in class 514, subclass 12.

IV. Claim 32, drawn to a method of modulating signal transduction in a cell, classified in class 514, subclass 12.

V. Claims 33-40, drawn to a method of influencing interaction between cells, classified in class 514, subclass 12.

Claims 39-40 are generic to a plurality of disclosed patentably distinct species comprising methods utilizing a SOCS gene comprising a nucleotide sequence set forth in SEQ ID NO:3, 5, 7, 9, 11, 13, 15, 16, 17, 20, 22, 23, 24, 26, 27, 28, 30, 31, 32, 33, 34, 35, 37, 38, 39, 40, 42, 43, 45 or 47 or a method wherein the SOCS gene encodes a protein comprising an amino acid sequence set forth in SEQ ID NO: 4, 6, 8, 10, 12, 14, 18, 21, 25, 29, 36, 41, 44, 46 or 48. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. The inventions are distinct, each from the other because of the following reasons:

The nucleic acids of Invention I are related to the polypeptide of Invention II by virtue of encoding same. The DNA molecule has utility for the recombinant production of the polypeptide in a host cell. Although the DNA molecule and polypeptide are related since the DNA encodes the specifically claimed polypeptide, they are distinct inventions because the polypeptide product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. Further, the DNA may be used for processes other than the production of the polypeptide, such as nucleic acid hybridization assay.

Invention I is related to Inventions III, IV and V as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids of Invention I can be used in the materially different process of nucleic acid hybridization assays.

Invention II is unrelated to Inventions III, IV and V since it is not disclosed as being used in the methods of Inventions III-V.

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Inventions III-V are unrelated to each other since each method has different purposes (III: method of modulating levels of a SOCS protein in a cell; IV: method of modulating signal transduction in a cell; V: method of influencing interaction between cells).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classification, restriction for examination purposes as indicated is proper.

"For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP 808.02." (see MPEP 803). The serious burden of search has been established by the separate classification and separate status in the art of the inventions.

Further, the restriction groups have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the inventions is not co-extensive particularly with regard to the literature search. A reference which would anticipate the invention of one group would not necessarily anticipate or make obvious any of the other groups. Moreover, as to the question of burden of search, classification of subject matter is merely one indication of the burdensome nature of the search involved. The literature search, particularly relevant in this art, is not co-extensive and is much more important in evaluating the burden of search. Burden in examining materially different groups having materially different issues also exist.

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4. A telephone call was made to Frank S. Digiglio on July 26, 1999 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

6. Claims 1-40 are restricted.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devesh Srivastava, Ph.D. whose telephone number is (703) 305-0775. The examiner can normally be reached on Monday-Thursday from 8:00 am to 5:30 pm and alternate Fridays from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Sisson, Ph.D. can be reached on (703) 308-3978. The FAX phone number for the Art Unit where this application or proceeding is assigned is (703) 308-0294. For direct submission of official papers, by facsimile, with the Patent Office, the FAX phone number is (703) 308-4242 or (703) 308-2742.

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Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is (703) 308-0196.

Devesh Srivastava, Ph.D.
Patent Examiner
September 2, 1999

B. S. Sisson

BRADLEY SISSON
SUPERVISORY PATENT EXAMINER
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9/2/99